

MAIL STOP INTERFERENCE  
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Paper 1

UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Patent Interference No. 105,135

**SCRIPPS RESEARCH INSTITUTE**

(5,622,931),  
Junior Party,

v.

**GENENTECH, INC.**  
(08/437,989 and 08/444,934),  
Senior Party.

**MAILED**

JUL 3 - 2003

PAT. & T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

**NOTICE DECLARING INTERFERENCE**  
(37 CFR § 1.611)

**A. Declaration of interference**

An interference is declared (35 U.S.C. 135(a)) between the captioned parties.

Details of the applications, patent, count, and claims designated as corresponding to the count appear under headings E and F of this NOTICE.

**B. Administrative patent judge assigned to administer the interference**

The interference has been assigned to Administrative Patent Judge Richard Torczon. 37 CFR § 1.610.

**C. Standing order**

A copy of the Trial Section STANDING ORDER (Paper 2) accompanies this NOTICE. The STANDING ORDER applies to this interference.

**D. Conference call to set dates**

A telephone conference call to set dates for action in this interference is scheduled for **4 p.m. (Eastern)** on **3 September 2003**. (The Board will initiate the call.)

No later than **two business days** prior to the conference call, each party shall file and serve by facsimile a list of the preliminary motions the party intends to file. See STANDING ORDER ¶ 10.

A copy of a sample order setting times for taking action during the preliminary motion phase of the interference accompanies this NOTICE. Counsel are encouraged to discuss the order by telephone prior to the telephone conference call and to reach an agreement as to dates for taking action. A typical preliminary motion period lasts approximately nine months. Counsel should be prepared to justify any request for a shorter or longer period.

The Board is conducting a pilot program in electronic filing of interference papers. The procedure is explained in University of New Mexico v. Fordham Univ., No. 104,761 (2001) (<http://www.uspto.gov/web/offices/dcom/bpai/its/104761-021.pdf>). Counsel should be prepared to discuss participation in the pilot program.

**E. The parties to this interference**

Junior Party

**Inventors:** Thomas S. EDGINGTON of La Jolla, CALIFORNIA, and James H. MORRISSEY of Oklahoma City, OKLAHOMA

**Patent:** 5,622,931, issued 22 April 1997 from 07/880,079, filed 29 April 1992

**Title:** Human tissue factor related DNA segments, polypeptides and antibodies

**Priority** 07/165,939, filed 9 March 1988 (5,223,427)  
**benefit:** 07/067,103, filed 25 June 1987 (5,110,730)

**Assignee:** The Scripps Research Institute of La Jolla, California

**Attorneys:** See last page

**Address:** See last page

Senior Party

**Inventors:** Richard M. LAWN of San Francisco,  
Gordon A. VEHAR of San Carlos, and  
Karen L. WION of Millbrae, all of CALIFORNIA

**Applications:** 08/437,989, filed 10 May 1995, and  
08/444,934, filed 22 May 1995

**Title:** Methods and deoxyribonucleic acid for the preparation of tissue factor protein

**Priority** 08/167,715, filed 15 December 1993  
**benefit:** 08/167,785, filed 15 December 1993  
07/969,863, filed 30 October 1992  
07/620,431, filed 30 November 1990  
07/035,409, filed 7 April 1987  
07/013,743, filed 12 February 1987

**Assignee:** Genentech, Inc. of South San Francisco, CALIFORNIA

**Attorneys:** See last page

**Address:** See last page

**F. Count and claims of the parties**

Count 1

A composition of claim 1 of the 5,622,931 patent.<sup>1</sup>

The claims of the parties are:

Scripps Research Inst.: 1 & 2

Genentech 989: 9, 11-14, 20, 22, 24-26, 30 & 32-48

Genentech 934: 4-6, 8, 20, 21, 23-25, 27, 28, 31-36 & 38-41

The claims corresponding to Count 1:

Scripps Research Inst.: 1 & 2

Genentech 989: 22, 39

Genentech 934: 4-6, 8, 20, 21, 23, 27, 28, 31-36 & 41

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<sup>1</sup> 931 claim 1:

A composition comprising an aqueous solution of human tissue factor heavy chain protein wherein said protein is soluble and has an amino acid residue sequence represented by FIG. 1 from position 1 to position 219.

FIG. 1:

ME	-30	-20	-10
	TPAWPRVPRP	ETAVARTLLL	GWVFAQVAGA
10	20	30	40
SGTTNTVAAY	NLTWKSTNFK	TILEWEPKPV	NQVYTVQIST
50	60	70	80
KSGDWKSFKCF	YTTDTECDLT	DEIVKDVKQT	YLARVFSYPA
90	100	110	120
GNVESTGSAG	EPLYENSPEF	TPYLETNLGQ	PTIQSFEQVG
130	140	150	160
TKVNVTVEDE	RTLVRNNNTF	LSLRDVFGKD	LIYTLYYWKS
170	180	190	200
SSSGKKTAKT	NTNEFLIDVD	KGENYCFCSVQ	AVIPSRTVNR
210	220	230	240
KSTDSPVECM	GQEKGEOFREI	FYIIGAVVFV	VIILVIIILAI
250	260		
SLHKCRKAGV	GQSWKENSPL	NVS	

The claims not corresponding to Count 1:

Scripps Research Inst.: None

Genentech 989: 9, 11-14, 20,<sup>2</sup> 24-26, 30, 32-38, & 40-48

Genentech 934: 24, 25 & 38-40

**G. Heading to be used on papers**

Addendum 1 provides the heading that shall be used on all papers filed in the interference. See STANDING ORDER ¶ 3.5.

**H. Summary of dates for taking action**

Addendum 2 provides a summary of dates and times for taking action set in the STANDING ORDER.

**I. Order form for requesting file copies**

Addendum 3 provides an order form for requesting file copies. Use of the form will expedite the processing of your request.

**J. Notice of intent to publish**

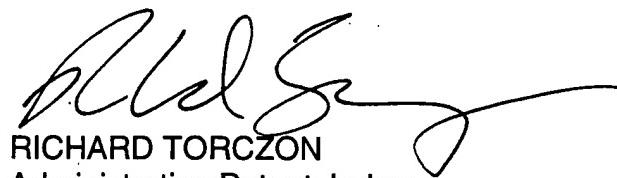
In the event that this proceeding should result in a decision or order that the Board believes would be of interest to the public, the decision or order will be published without redaction unless, within sixty days of the entry date of this notice of declaration a party files as a separate paper a notice that specifically identifies information in its application that is not already publicly available that would warrant redaction.

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<sup>2</sup> Although 989 claim 22 corresponds to the count, its ostensible parent claim, claim 20, does not because claim 22 does not further limit claim 20 as required under 35 U.S.C. 112[4]. Given the contradictory scopes of claims 20 and 22, claim 22 is indefinite within the meaning of 35 U.S.C. 112[2]. Claim 39, which depends from claim 22, is similarly indefinite.

If, after filing such notice, specifically identified information becomes publicly available (for example, through publication of a collateral application), the party shall promptly notify the Board of this change in the status of the information.

The parties are reminded that, in any case, at the end of the proceeding all of the information in the proceeding may be publicly available pursuant to 37 CFR § 1.11(e).



RICHARD TORCZON  
Administrative Patent Judge

Enclosures:

- Copy of STANDING ORDER (Paper 2)
- Copy of order used for setting times for taking action in the preliminary motion phase of the interference
- Copy of order used for setting times for taking action in the priority phase of the interference
- Form PTO-850
- Copy of U.S. Patent 5,622,931
- Copy of the involved application claims

Interference No. 105,135  
Scripps Research Inst. v. Genentech, Inc.

Paper 1  
Page 7

cc (via overnight carrier):

For Scripps Research Institute:

Thomas Fitting  
SCRIPPS RESEARCH INSTITUTE  
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For Genentech, Inc.:

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Jerome R. Smith  
HOLLAND & KNIGHT LLP  
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Fax: 404-881-0470

Interference No. 105,135  
Scripps Research Inst. v. Genentech, Inc.

Paper 1  
Page 8

ADDENDUM 1

Filed on behalf of: Party \_\_\_\_\_

Paper No. \_\_\_\_<sup>3</sup>

By: Name of lead counsel

Name of backup counsel

Street address

City, State, and ZIP Code

Tel:

Fax:

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES  
(Administrative Patent Judge Torczon)

**SCRIPPS RESEARCH INSTITUTE**  
(5,622,931),  
Junior Party,

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**GENENTECH, INC.**  
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Senior Party.

Patent Interference No. 105,135

TITLE OF PAPER

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<sup>3</sup> Leave blank for the Board to insert the paper number when the paper is entered into the administrative record.

## ADDENDUM 2

### SUMMARY OF DATES FOR TAKING ACTION

Dates and times for taking action are set in the following paragraphs of the

#### STANDING ORDER:

<u>Date</u>	<u>Paragraph</u>
Identifying lead and backup counsel .....	¶ 4
Identifying any real party in interest .....	¶ 5
Requesting copies of involved and benefit applications and patents .....	¶ 6
Accomplishing certain discovery .....	¶ 7
Filing clean copy of claims .....	¶ 8
Filing clean copy of claims in cases with drawings or claims containing a means-plus-function limitation .....	¶ 9
Filing list of proposed preliminary motions .....	¶ 10
Filing oppositions to Rule 635 miscellaneous motions and dates for filing replies to oppositions .....	¶ 13.10.2
Objecting to admissibility of evidence .....	¶ 14.1.1
Serving supplemental affidavits or evidence to respond to objection to admissibility of evidence .....	¶ 14.2
When cross-examination can take place .....	¶ 14.3
Taking action with respect to settlement discussions .....	¶ 15.2

**ADDENDUM 3**

**FILE COPY REQUEST**  
Patent Interference No. 105,135

Attach a copy of section E of this NOTICE to this REQUEST. On the copy, circle each patent and application that you are requesting.

Include the following information to facilitate processing of this REQUEST:

1. Charge fees to USPTO Deposit Account No. \_\_\_\_\_
2. Complete address, including street, city, state, zip code and telephone number (do not list a Post Office box because file copies are sent by commercial overnight courier).  
\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_

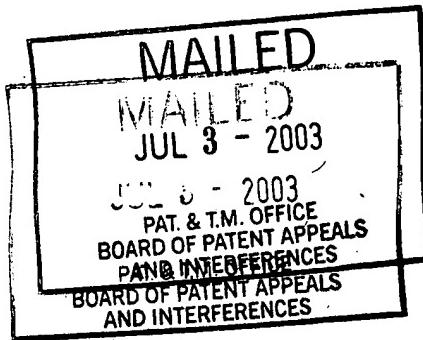
3. Telephone, including area code: \_\_\_\_\_



# UNITED STATES PATENT AND TRADEMARK OFFICE

DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE  
 BOARD OF PATENT APPEALS AND INTERFERENCES  
 BOX INTERFERENCE, WASHINGTON, D.C. 20231

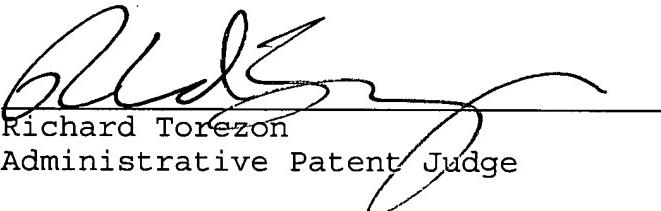
Filed by: Richard Torczon  
 Telephone: (703) 308-9797  
 Facsimile: (703) 305-0942



Applicants: Lawn et al.  
 Application No.: 08/444,934  
 Filed: 05/22/95  
 For: Methods and deoxyribonucleic acid  
 For the preparation of tissue  
 factor protein

The above-identified application or patent has been forwarded to the Board of Patent Appeals and Interferences because it is adjudged to interfere with another application or patent. An interference has been declared. The interference is designated as No. 105,134.

Notice is hereby given the parties of the requirement of the law for filing in the Patent and Trademark Office a copy of any agreement "in connection with or in contemplation of the termination of the interference." 35 U.S.C. § 135(c).

  
 Richard Torezon  
 Administrative Patent Judge

## **INTERFERENCE DIGEST**

Interference No. 105,134

Paper No. 36

Name: Richard M. Lawn, et al.

Serial No.: 08/444,934

Patent No.

Title: Methods and deoxyribonucleic acid for the preparation of tissue factor protein

Filed: 05/22/95

Interference with Nemerson et al.

### **DECISION ON MOTIONS**

Administrative Patent Judge, \_\_\_\_\_ Dated, \_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_

### **FINAL DECISION**

Board of Patent Appeals and Interferences, J. Nemerson Dated, 11-24-04  
\_\_\_\_\_  
\_\_\_\_\_

Court, \_\_\_\_\_ Dated, \_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_

### **REMARKS**

This should be placed in each application or patent involved in interference in addition to the interference letters.



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**MAILED**

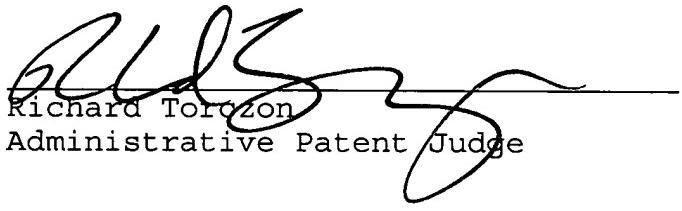
JUL 3 - 2003

PAT. & T.M. OFFICE  
 BOARD OF PATENT APPEALS  
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 Richard Torczon  
 Administrative Patent Judge

## INTERFERENCE DIGEST

Interference No. 105,135

Paper No. 38

Name: Richard M. Lawn, et al.

Serial No.: 08/444,934

Patent No.

Title: Methods and deoxyribonucleic acid for the preparation of tissue factor protein

Filed: 05/22/95

Interference with Edgington et al.

### DECISION ON MOTIONS

Administrative Patent Judge, \_\_\_\_\_ Dated, \_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_

### FINAL DECISION

Board of Patent Appeals and Interferences, favorable Dated, 5/25/05  
\_\_\_\_\_  
\_\_\_\_\_

Court, \_\_\_\_\_ Dated, \_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_

### REMARKS

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